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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,228	08/21/2006	Holger Listle	10191/4473	6923
26646 7590 06/08/2009 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
			EXAMINER	
			ZANELLI, MICHAEL J	
		ART UNIT	PAPER NUMBER	
		3661		
		MAIL DATE	DELIVERY MODE	
		06/08/2009		PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/590,228

**Applicant(s)**

LISTLE, HOLGER

**Examiner**

Michael J. Zanelli

**Art Unit**

3661

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 8/21/06
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This application has been examined. The preliminary amendment filed 8/21/06 has been entered. Claims 6-10 are pending.
2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
3. The IDS filed 8/21/06 has been considered.
4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the navigation system comprising a drive and data medium, as set forth in claim 1, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 6-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. As per claims 6 and 10, the claims are directed to a navigation system and a method for operating a navigation system; however, the claims fail to recite any structures capable of, or method steps directed to, performing navigation. At best the claims define a drive for reading a data medium.

B. All claims depending from a rejected base claim are also rejected as containing the same deficiencies.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6-8 and 10, as best interpreted given the deficiencies noted above, are rejected under 35 U.S.C. 103(a) as being unpatentable over Tada (2003/0084313) in view of Jamail (5,995,457).

A. As per claims 6 and 10, Tada discloses a navigation system (Fig. 2) and method for handling map (navigation) data stored on a portable storage medium.

The system includes a drive device (17) and a data medium (30) configured to store navigation data and includes identification information (i.e., serial number) stored on the medium and is utilized to prevent illegal use/copying of the navigation data stored on the storage medium [0037-0038; 0043-0044]. The claimed invention differs in that the identification information is stored in a pregap on the storage medium. Tada merely states that the identification information is stored on the storage medium [0038].

B. Jamail discloses known ways of configuring storage media whereby pregap areas are provided separate from the readable data. The pregap may be used as an auxiliary storage area for storing "concealed" data related to the functionality of the drive device (col. 6: 44-48; col. 9:11-25, 51-57; col. 10:10-12). One of ordinary skill in the art would have found it obvious to utilize the pregap to store the identification information (i.e., "concealed" data) of Tada such that the functionality of the drive device (17) may be controlled to prevent illegal copying.

C. As per claim 7, as above whereby Tada discloses that the particular storage medium may take various forms, including CD-ROM [0052].

D. As per claim 8, as above whereby Jamail further discloses that the pregap is located above the start of the "non-concealed" readable data (col. 6:26-27).

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tada in view of Jamail as applied to claim 6 above, and further in view of Tanaka et al. (6,560,403; 6,618,335) and Beresson (6,081,897).

- A. Tada and Jamail are applied as above. The claimed invention differs in that a copyright note is stored in the pregap. One could reasonably interpret that the serial number information provided by Tada is a type of "copyright note" insofar as it enables the data to be legally copied. However, even if one were to interpret "copyright note" in a narrower sense, it was known in the art to provide a copyright note in a storage area separate from the readable data section.
- B. The relevant prior art teaches that one may reduce illegal copying by providing a "copyright note" in a reserved memory sector (concealed track; table of contents, etc.) separate from the readable data (see as exemplary Tanaka '403: col. 2:49-59; Tanaka '335: col. 1:18-28; Bersson: col. 1:57-61). One of ordinary skill in the art would have found it obvious to modify the combination of Tada and Jamail as noted above for claim 6 to include a copyright notice along with the other identification information stored in the pregap to provide an additional level of protection against illegal copying.
10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Zanelli whose telephone number is (571) 272-6969. The examiner can normally be reached on Monday-Thursday 9:00 AM - 4:00 PM.
- If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas G. Black can be reached on (571) 272-6956. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael J. Zanelli/  
Primary Examiner  
Art Unit 3661